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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,700

02/16/2001

Robert M. Szabo

6169-156

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40987

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03/21/2007

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/785,700

Applicant(s)

SZABO ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-13 and 16-24 have been examined. Application 09/785,700 (METHOD AND APPARATUS FOR STIMULATING COMMERCE) has a filing date 02/16/01.

Response to Amendment

2. In response to Advisory Action filed 11/30/2006, the Applicant filed an RCE on 01/05/2007.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 7-13, 16, 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Barenbaum (US 2001/0039514).

As per claims 1, Barenbaum teaches:

A computer-implemented method of providing promotional material to consumers comprising:

generating in a merchant computer system a merchant request to stimulate commerce for merchant-specified products (see paragraph 21);

establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system wherein the merchant request is conveyed to the third party shopping stimulation system (see paragraphs 29; 48) ;

reading with said third-party remote shopping simulation system consumer purchase information from a plurality of merchant computer systems, said consumer purchase information comprising consumer identifying information and product information (see paragraph 48);

based at least in part on said consumer purchase information, identifying one or more potential consumers who have previously purchased one or more of the merchant-specified products (see paragraphs 21, 48 and 50);

determining that at least one of the merchant-specified products is an obsolete product when a new or alternate version of the at least one merchant-specified product is expected to be introduced within a predetermined time period, and identifying the at least one merchant-specified product as an obsolete product (see paragraphs 18, 19 "end of summer season with an abundant of summer dresses and sandals");

in said third-party remote shopping stimulation system, generating promotional material of the one or more potential customers identified as having previously purchased the at least one merchant-specified product identified as an obsolete product, and associating said promotional material corresponding to said at least one merchant-specified product with said identified consumers (see paragraphs 18, 19, 21 and 35) and

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 21).

As per claim 3, Barenbaum teaches:

The method of claim 1, wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 23 and 41).

As per claim 4, Barenbaum teaches:

The method of claim 1, wherein each said step is performed responsive to the merchant system detecting a business necessity corresponding to the product identified as an obsolete product, wherein said business necessity corresponds to a merchant of product identified as an obsolete product having excess inventory of the product identified as an obsolete product (see paragraphs 18-19 and 21).

As per claim 5, Barenbaum teaches:

The method of claim 1, wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see paragraphs 47-48).

As per claim 6, Barenbaum teaches:

The method of claim 1, wherein the one or more merchant-specified products comprise a service (see paragraph 18).

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As per claims 7 and 22, Barenbaum teaches:

The method of claim 1, said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is additionally based upon the expiration information of products (see paragraph 19 “events have a start and end date”).

As per claim 8, Barenbaum teaches:

The method of claim 1, wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 21).

As per claim 9, Barenbaum teaches:

The method of claim 1, wherein said promotional material made available to said identified consumers is in printed format (see paragraph 5).

As per claim 10, Barenbaum teaches:

A system for providing promotional material to consumers comprising:

a merchant computer system configured to generate a merchant request to stimulate commerce for one or more merchant-specified products;

a merchant inventory management system configured to track shipments received by one or more merchants of the one or more merchant-specified products (see paragraphs 18 and 50);

a shopping stimulation logic unit in communication with said merchant inventory management system for determining that at least one merchant-specified product is an obsolete product when a new or alternate version of the at least one merchant-specified product is expected to be introduced within a predetermined time period, and identifying

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that at least one merchant-specified product as an obsolete product (see paragraphs 18, 19, 21 and 50);

a promotional information database, accessible by said shopping stimulation logic unit, and comprising consumer identifying information identifying one or more potential consumers who have previously purchased the at least one merchant-specified product identified as an obsolete product (see paragraphs 21, 35) and

a promotional material delivery system configured to generate promotional material for the one or more potential customers identified as having previously purchased the at least one merchant-specified product identified as an obsolete product and to make said promotional material available to said identified consumers (see paragraphs 21 and 35).

As per claim 16, Barenbaum teaches:

A computer-implemented method of providing promotional material to consumers comprising:

establishing a computer communications session between a merchant computer system and a third-party remote shopping stimulation system (see paragraphs 30-31);

reading with said third-party remote shopping stimulation system consumer purchase information from a plurality of merchant computer systems, said consumer purchase information comprising consumer identifying information and product information corresponding to merchant-specified products (see paragraphs 21 and 35);

determining the at least one of the merchant-specified products is an obsolete product when a new or alternate version of the at least one merchant-specified product

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is expected to be introduced within a predetermined time period, and identifying the at least one merchant-specified product as an obsolete product (see paragraph 18 and 19);

determining that at least one of the merchant-specified products is an obsolete product when the at least one merchant-specified product has reached an end of a product life-cycle of the merchant-specified product, and identifying the at least one merchant-specified product as an obsolete product; and, in response to determining that at least one of the merchant-specified products is an obsolete product, identifying one or more potential consumers of obsolete product based at least in part on said consumer purchase information (see paragraphs 18, 19, 21 and 35);

in said third-party remote shopping stimulation system, generating promotional material for the identified obsolete product and associating said promotional material corresponding to said identified obsolete product with said identified consumers (see paragraph 21); and

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 21).

As per claim 11, Barenbaum teaches:

The system of claim 10, further comprising:

a consumer purchase information data structure for storing consumer identifying information and product information corresponding to a purchase transaction (see paragraph 35).

As per claim 12, Barenbaum teaches:

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The system of claim 10, further comprising:

a commerce system for collecting said consumer purchase information in a computer communications network environment (see paragraph 35).

As per claims 13 and 18, Barenbaum teaches:

The method of claim 10, wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 23 and 41).

As per claim 19 Barenbaum teaches:

The method of claim 16, wherein each said step is performed responsive to the merchant system detecting a business necessity corresponding to the product identified as an obsolete product, wherein said business necessity, corresponds to a merchant of product identified as an obsolete product having excess inventory of the product identified as an obsolete product (see paragraphs 18-19 and 21).

As per claim 20, Barenbaum teaches:

The method of claim 16, wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see paragraphs 47-48).

As per claim 21, Barenbaum teaches:

The method of claim 16, wherein the merchant-specified products comprise a service (see paragraph 18).

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As per claim 23, Barenbaum teaches:

The method of claim 16, wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 21).

As per claim 24, Barenbaum teaches:

The method of claim 16, wherein said promotional material made available to said identified consumers is in printed format (see paragraph 5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barenbaum (US 2001/0039514) in view of Deaton (US 6,611,811).

As per claim 2, Barenbaum fails to teach:

The method of claim 1, said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of the least one merchant-specified product. However, Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for

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each ID. This consumption rate is compared with the date of last purchased so that a prediction of next purchase may be made" (see Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable products, which typically need to be consumed in less than one week, such as milk, as taught by Deaton in order to target incentives to customers based upon a match between said perishable product due date and a merchant over-stocked or low revenue products. This feature would allow the Barenbaum system improve the capacity management of time sensitive products or services and therefore, offset over capacity or low revenues.

As per claim 17, Barenbaum fails to teach:

The method of claim 16, said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of each of the merchant-specified products. However, Deaton teaches "A consumption rate analysis is performed based on historical product purchases. Non-perishable products that may typically be consumed over a period of more than one week are analyzed to determine the rate in which they are consumed for each ID. This consumption rate is compared with the date of last purchased so that a prediction of next purchase may be made" (see Deaton column 70, lines 4-25; column 90; column 118, lines 52-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Barenbaum would make a consumption rate analysis for perishable products, which typically need

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to be consumed in less than one week, such as milk, and would transmit incentives to customers for such perishable products, when the product expiration is due, as taught by Deaton and when Barenbaum system notice a over-stocked or low revenue for said perishable products. This feature would allow the Barenbaum system to track perishable and non-perishable products and send corresponding incentives when the next due date to purchase a type of product arrives.

Response to Arguments

5. Applicant's arguments filed 11/06/2006 have been fully considered but they are not persuasive. The Applicant argues that the Applicant's claimed invention is fully supported by the disclosure of the Applicant's declaration 1.131. The Examiner answers that Applicant's affidavit disclosure created on 03/20/2000 simply describes the concept of tracking the expiration date and/or life expectancy of items purchased by consumers and notifying said consumers with advertisements that replenishment was needed based on items previously purchased expiring or exceeding their useful life. Targeting consumers based upon the expiration date or products exceeding their useful life is not the same as targeting advertisements to consumers based upon previously purchased items becoming obsolete because a new or alternate version of the at least one merchant-specified product is expected to be introduced within a predetermined time period, as recited in Applicant's claim 1. For example, the Examiner had had computers that had lasted for more than 4 years and also had had computers that the only had lasted 1 year, therefore, the useful life of one computer can be different from another, however, all of said computers became obsolete the first month after the Examiner

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purchased said computers because new versions of said computers were released one month after said purchasing. Therefore, contrary to Applicant's argument, Applicant's affidavit does not show proof that the Applicant conceived the claimed invention prior the filing date of Barenbaum, which is 04/04/2000.

Furthermore, Applicant's affidavit is defective in proving diligence because the Applicant must account for the entire period during which diligence is required, which in the Applicant's case is from March 20, 2000 to February 16, 2001 which is almost 11 month. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959). The Applicant simply mentioning in his Affidavit page 2 , section 6 that the he conceived the present claimed invention from at least as early as March 20, 2000, and exercised due diligence from that date to February 16, 2001 is not enough proof that the Applicant was diligent.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

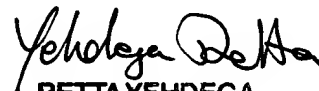
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
March 12, 2007


RETTAYEHDEGA
PRIMARY EXAMINER